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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/759,031 01/12/01 YEATS

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EXAMINER

IM52/1107

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MOORE, M  
ART UNIT

PAPER NUMBER

1712  
DATE MAILED:

11/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/759,031

Applicant(s)

Yeats et al.

Examiner

Margaret Moore

Art Unit

1712



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other:

1. Claims 9 and 10 provide for the use of a coating composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9 and 10 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The weight percents of each (meth)acrylate is improper, as they do not total 100%. For instance, the mixture can never have 75% by weight of glycidyl methacrylate, because this will result in a total of at least 105% by weight of reactants. In addition, it is impossible to have 60% by weight methyl methacrylate, because this will result in a composition having 105% by weight reactants.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 6, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaki et al

Yamaki et al. teach a coating composition containing an acrylic resin having glycidyl groups, a polysiloxane diol and a hardener. This corresponds to each of the claimed components. See for instance the various Components (B), prepared on columns 18 and 19, and component C-1, which meets the claimed siloxane formula. Tables 1 through 4 show various compositions which meet each of the claimed components, including acrylic polymers meeting the requirements of claims 4 and 6. These compositions are used to coat various substrates such as boats and cars. The bottom of column 13 teaches that this composition can be cured at ambient temperature.

7. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaki et al.

Patentees fail to teach this product by process limitation. However, the resulting compositions as found in the Yamaki et al. and the claims appears to be inherently the same, since both compositions containing the same components regardless of the means by which the components are formed. As such, this product by process limitation appears to be inherently met by the final composition in Yamaki et al.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al.

While Yamaki et al. fail to explicitly show an acrylic resin having a methyl methacrylate reactant, such reactants are within the teachings of the acrylic resin therein. See for instance col. 8, lines 16 to 25. It would have been well within the teachings of Yamaki et al. to include such a monomer into the acrylic resin composition and thus one having ordinary skill in the art would have found this claim obvious.

9. Claims 1 to 4, 6, 9 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yabuta et al.

Yabuta et al. teach a curable composition containing an acrylic glycidyl resin, and reactive organopolysiloxane and a catalyst. See for instance the resin prepared in Preparation Example 3 and Comparative Preparation Examples 1 and 2. Also note the reactive organopolysiloxane C shown on the bottom of column 18. Table 1 shows various compositions meeting those claimed. Yabuta et al. do not teach that this composition is "ambient temperature curing". Rather Yabuta et al. teach that the composition is heat curable. However, the reactive components in Yabuta et al. are the same as that in the instant claims. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. If the prior art teaches an identical chemical structure the properties applicants disclose and/or claim are necessarily present. Since the composition claimed is met by these examples in the prior art, the inherent property of ambient temperature curing claimed must also be inherently present in the prior art.

For the record, the Examiner notes that a composition may be *able* to be cured at ambient temperature, but is still heat cured, perhaps to improve cure time or the final cured product. Just because a composition is disclosed as being heat cured does not mean that it is not *able* to be cured ambient temperature. Note for instance the bottom of column 13 of Yamaki et al. that teaches the composition can be cured at ambient temperature or a heated temperature.


10. Claims 1 to 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woo et al.

Woo et al. teach an acrylic modified silicone resin, in which the acrylic monomers are polymerized in the presence of the silicone resin. Note the bottom of column 2 which teaches glycidyl acrylic monomers, and Examples 1 to 3 which meet the limitations of claims 4 and 5. Column 3 teaches that useful silicon resins are of the formula shown, which embraces the claimed formula. Note too that patentees teach a preferred molecular weight range that anticipates that claimed.

Thus the only difference between claim 1 and the teachings of Woo et al. is that patentees do not specifically show a polysiloxane meeting the formula shown. However, as noted supra, the general silicone resin taught by Woo et al. is inclusive of that claimed. In fact, upon reading the teachings of Woo et al., the skilled artisan would be directed towards a polysiloxane as claimed. Note for instance that the explicitly delineated molecular weights of 500 and 600 meet the claimed molecular weight. Note that useful resins in Woo et al. are taught as those having at least 2 hydroxyl groups. In view of the definitions of R, then, this suggests a polysiloxane having terminal hydroxyl groups, and thus having the formula shown. On the other hand, Woo et al. suggests polysiloxanes having at least 2 methoxy groups. Such groups could be present on the structure shown by Woo et al. either on the backbone, or the terminal groups. Either way, the resulting silicone resin meets the claimed formula. In this manner the instant claims would have been obvious to one having ordinary skill in the art.

11. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) **872-9310**. All other **official** faxes should be sent to (703) **872-9311**. Please do not send any informal communication or proposed amendments to this number.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
nov. 6, 2001